

### **REMARKS**

In accordance with the foregoing, claims 1-16 have been amended, and claims 1-29 are pending and under consideration. No new matter is presented in this Amendment.

It is noted that this Amendment is in reply to the Office Action mailed January 11, 2008, which is designated as a final action. However, as indicated in the Examiner Interview Summary Record dated January 8, 2008 (available on PAIR), the finality of this office action was withdrawn. Accordingly, it is respectfully submitted that this Amendment should be treated as responsive to a non-final Office Action.

### **REJECTIONS UNDER 35 U.S.C. §101:**

Claims 1-16 are rejected under 35 U.S.C. §101. At page 2 of the Office Action, the Examiner alleges that the claimed invention is directed to non-statutory subject matter for two reasons: "(1) it does not recite the information storage medium to be computer-readable; and (2) it contains only data (maximum recording speed information, minimum recording speed information, maximum reproducing speed information, and minimum reproducing speed information). Data, contrary to a set of computer-executable instructions, do not impart functionality to a computer or a computing device." Responses to these two reasons for rejecting claims 1-16 under 35 U.S.C. §101 are provided below in turn.

#### **(1) Claims 1-16 Have Been Amended To Recite A "Computer-Readable Medium"**

In response to reason (1), which alleges that claims 1-16 are directed to non-statutory subject matter because claims 1-16 do not recite the information storage medium to be computer-readable, claim 1 has been amended to recite "~~An information storage~~ computer readable medium to be accessed by a drive." Support for this amendment can be found, for example, at paragraphs [0037]-[0039] and FIG. 5. Paragraph [0037] discloses "a drive device for recording and/or reproducing data on an information storage medium according to the present invention." This drive device includes an audio/video (AV) encoder 110, a digital signal processor 120, a radio frequency (RF) amplifier 130, a pickup 140, a servo 150, and a system controller 160. As explained at paragraph [0038], the system controller 160 controls the entire drive system to record or reproduce data on the disk, which is mounted on the turntable of the pickup. This system controller 160 is illustrated in FIG. 5. Paragraph [0039] discloses that when

a storage medium according to the present invention has been inserted into such a drive device, the drive device reads out the speed information and records and/or reproduces data by referring to the read-out speed information.

It is respectfully submitted that the information storage medium and drive device described in paragraphs [0037]-[0039] and shown in FIG. 5 provide written description support for the amendment to claim 1. The system controller 160 is a type of computer, which controls the drive system to record or reproduce data on the disk. More generally, the entire drive device is also a computer. Furthermore, paragraph [0039] states that the drive device "reads out the speed information" from the storage medium. Thus, the information storage medium is read by a computer. Therefore, the information storage medium disclosed by the specification is a type of medium read by a computer, i.e., a "computer-readable medium." Since claim 1 has been amended to recite a "computer readable medium," it is respectfully submitted that the amendment to claim 1 is supported by the disclosure of the specification.

Claims 2-16 have been amended to be consistent with the amendment to claim 1.

## **(2) Claims 1-16 Impart Functionality To The Drive Device**

In response to reason (2), which alleges that claims 1-16 are directed to non-statutory subject matter because claims 1-16 "contain only data...[which] do not impart functionality to a computer or a computing device," it is respectfully submitted that claims 1-16 impart functionality to the drive device, and that the rejection of claims 1-16 under 35 U.S.C. §101 should be withdrawn.

Claim 1 recites:

"A computer readable medium to be accessed by a drive, the information storage medium comprising a reproduction-only area in which maximum recording speed information, minimum recording speed information, maximum reproducing speed information, and minimum reproducing speed information which indicate whether the drive can record and reproduce data on the information storage medium are recorded (emphasis added)."

The maximum recording speed information, minimum recording speed information, maximum reproducing speed information, and minimum reproducing speed information recited by claim 1 impart the function of indicating whether the drive can record and reproduce data on the information storage medium. Indicating whether a drive can record and reproduce data on

an information storage medium is a function. The clear language of claim 1 recites functional descriptive material, and is statutory subject matter for that reason. MPEP 2106.01.

In the rejection of claim 1, the Examiner relies on Annex IV of The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, published in the Official Gazette on November 22, 2005, to support the Examiner's argument that claims 1-16 do not comply with 35 U.S.C. §101. The section of Annex IV quoted by the Examiner states:

"'nonfunctional descriptive material' includes but is not limited to music, literary works and a compilation or mere arrangement of data." Thus, for example, a claim which simply recites music is not statutory subject matter.

However, the same section of Annex IV states the following:

"The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implement a statutory process (emphasis added)." MPEP 2106.01 (II) (quoting Annex IV of The Interim Guidelines).

By way of analogy to this above-quoted passage, it is respectfully submitted that claim 1 is directed towards statutory subject matter. The computer-readable medium recited by claim 1 is much more similar to the example of statutory subject matter provided by Annex IV than the example of nonstatutory subject matter provided by Annex IV. Claim 1 does not simply recite "data," e.g., "music." Instead, claim 1 recites an "information storage medium comprising a reproduction-only area in which maximum recording speed information, minimum recording speed information, maximum reproducing speed information, and minimum reproducing speed information which indicate whether the drive can record and reproduce data on the information storage medium are recorded." Like the particular grouping of musical notes which cause another defined series of notes to be played, the maximum recording speed information, minimum recording speed information, maximum reproducing speed information, and minimum reproducing speed information recited by claim 1 indicate whether the drive can record and reproduce data to and from the information storage medium. The speed information recited by claim 1 is not "data per se," because claim 1 does not simply recite the speed information. Rather, claim 1 recites functional descriptive material recorded on a computer-readable medium

which performs a real-world function of indicating whether a drive can record and reproduce data. Thus, it is respectfully submitted that Annex IV, upon which the Examiner relies on in rejecting claim 1, actually supports the argument that claims 1-16 are directed towards statutory subject matter.

Furthermore, recent case law suggests that the information storage medium 1 recited by claim 1 complies with the requirements of 35 U.S.C. §101. For example, in the recent Federal Circuit decision *In Re Nuijten*, the Federal Circuit upheld claim 15 of U.S. patent application no. 09/211,928, which recites:

“A storage medium having stored thereon a signal with embedded supplemental data, the signal being encoded in accordance with a given encoding process and selected samples of the signal representing the supplemental data, and at least one of the samples preceding the selected samples is different from the sample corresponding to the given encoding process.”

The signal recited by claim 15 of U.S. patent application no. 09/211,928 recites even less functionality than the maximum recording speed information, minimum recording speed information, maximum reproducing speed information, and minimum reproducing speed information recited by claim 1. Despite this bare amount of functionality recited by claim 15, the Federal Circuit Court of Appeals upheld the Board's decision that claim 15 did in fact meet the minimum requirements of 35 U.S.C. §101.

In contrast, the maximum recording speed information, minimum recording speed information, maximum reproducing speed information, and minimum reproducing speed information recited by claim 1 indicate to a drive whether the drive can record and reproduce data to and from the information storage medium. Unlike the signal claimed in claim 15 of U.S. patent application no. 09/211,928, the recording and reproducing speed information recited by claim 1 performs the function of indicating whether a drive can record and reproduce data to and from the information storage medium. By doing so, claim 1 recites an invention which achieves “economy in expenditures” because “since an old drive can record and/or reproduce data on an upgraded storage medium by using the speed information, using a new drive is unnecessary.” Par. [0041], specification. Thus, since the Federal Circuit upheld claim 15 of U.S. patent application no. 09/211,928, and since the functionality of the speed information recited by claim 1 is more substantial than the functionality of the signal recited by claim 15 of U.S. patent application no. 09/211,928, it is respectfully submitted that this recent case law also supports the

argument that claim 1 is directed towards statutory subject matter.

Moreover, although claims 1-16 have been amended to recite “~~An information storage computer readable~~ medium,” it is noted that the term “information storage medium” is not only an acceptable term for claim language in compliance with 35 U.S.C. 101, but is also a widespread term. For example, a “quick search” of all recently issued patents which were issued within approximately the past 3 months, and which have the term “information storage medium” recited in the claims, yielded over 50 issued patents. Such patents included, for example, U.S. Pat. No. 7,283,454 (claiming “an information storage medium comprising: an area including a recordable zone...a user data area...”), U.S. Pat. No. 7,286,454 (claiming “an information storage medium having a lead-in area, a user data area and a lead-out area, the information storage medium comprising: an information storage layer comprising an optimal power control area for obtaining an optimal recording condition...”), U.S. Pat. No. 7,301,878 (claiming “an information storage medium having a spirally or coaxially formed track or tracks on which given areas are sequentially arranged...”), and U.S. Pat. No. 7,313,319 (claiming “an information storage medium for reading by a computer device and having recorded video data including a plurality of unit compressed video data portions correlated with successive periods on a time axis...”).

These issued patents indicate that the term “information storage medium” is an acceptable term in claim terminology. Thus, although claims 1-16 have been amended to recite “a computer-readable medium” in this case, it is respectfully submitted that there is nothing inherently wrong under 35 U.S.C. §101 with a claim directed towards an “information storage medium.” As shown by the search results above, the U.S.P.T.O. routinely issues patents claiming “an information storage medium.” Furthermore, neither the MPEP nor the courts have implemented a *per se* rule barring claim language reciting “an information storage medium.”

Thus, it is respectfully submitted that the rejection of claim 1 should be withdrawn for at least these reasons.

Claims 2-16 depend on claim 1. Accordingly, it is respectfully submitted that the rejections of claims 2-16 should be withdrawn for substantially the same reasons that the rejection of claim 1 should be withdrawn.

For the foregoing reasons, it is respectfully submitted that the rejections of claims 1-16 should be withdrawn.

**ALLOWABLE SUBJECT MATTER:**

Claims 17-29 are allowed.

**CONCLUSION:**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 1/29/08

By:   
Michael D. Stein  
Registration No. 37,240

1400 Eye St., NW  
Suite 300  
Washington, D.C. 20005  
Telephone: (202) 216-9505  
Facsimile: (202) 216-9510